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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 02/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

APL

Office Action Summary

Application No.

09/734,045

Applicant(s)

GORELICK ET AL.

Examiner

Nathan Hillery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Notice filed on 9/3/03.
2. Claims 1 – 9 are pending in the case. Claims 1, 8, and 9 are independent.

Claim Objections

3. Claims 3 and 4 are objected to because of the following informalities: unclear or misuse of language. Specifically, the last line of claim 3 recites "the test of the web page"; the Office assumes that "test" should be text. Also, line 5 of claim 4 recites "mousing clicking"; the Office recommends deleting the word "mousing". Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Rodkin et al. (US006092074A).
6. **Regarding independent claim 1**, Rodkin et al. teach that *the content server 410 may provide hypertext links only for character strings in the on-line article 405 which match a local database of stored character strings at the content server, and/or which have no corresponding destination address. If a character string in the on-line article*

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405 does not match the database of stored character strings or has no corresponding destination address, no link is provided (Column 12, lines 43 – 49) and that the Intelligent AnnotatorTM 520 may insert the destination address itself, e.g., a URL ... into the article to be annotated (Column 19, lines 33 – 36), which provide for **comparing the text to one or more character strings contained in a database in order to identify specific character strings from the database that appear in the text, wherein each of the character strings has an associated hyperlink that is also contained in the database; and for each of the identified character strings contained in the text, inserting the associated hyperlink into the webpage.**

7. Regarding dependent claims 3 and 4, Rodkin et al. teach that a computer user viewing the page can access the referenced document simply by selecting the highlighted text in the instant file, e.g., by clicking on the highlighted text with a mouse or other pointing device. A markup language anchor, or markup language hyperlink, is the reference icon on a Web page which links a user's Web browser to relevant information. An HTML anchor, or HTML hyperlink, is the underlined text on a Web page which links a user's Web browser to another location. (Column 1, lines 26 – 35) and that in the above examples where it was indicated that a content server administrator input 530 may be used, generally such input is optional as the present invention provides the capability for fully automatic insertion of hypertext link codes into the article to be annotated (Column 20, lines 55 – 59), which provide that **the hyperlinks are inserted into the text of the webpage and for reconfiguring computer code used to form the**

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webpage such that the identified character strings change appearance and the user may select the hyperlink by clicking on the identified character strings.

8. **Regarding independent claim 9**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, and 5 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodkin et al. (US006092074A).

11. **Regarding dependent claim 2**, Rodkin et al. do not explicitly teach that **the text comprises content of a newsgroup article**. However, Rodkin et al. do teach that *the content server 410 processes an on-line text article 405 using an executable Intelligent Annotator.TM. 412 to automatically associate hypertext anchor codes with various character strings in the article. A resulting on-line article with hypertext 415 can be produced and stored locally on the content server 410* (Column 12, lines 31 – 36). It would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. on newsgroup articles so that the users can process all types of on-line text articles including newsgroup articles.

12. **Regarding dependent claim 5**, Rodkin et al. do not explicitly teach **providing a designation for a product to producers of the text, and wherein the database**

includes the designation as one of the character strings. However, Rodkin et al. do teach that *the method may comprise the further steps of receiving designated character strings ... wherein the designated character strings are designated by an administrator input at the primary computers; updating the annotation database with the designated character strings if the designated character strings are not present in the annotation database* (Column 10, lines 25 – 32). It would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. to designate a product to producers, by administrator input, so that the producers could provide their readers with further information about their product.

13. **Regarding dependent claim 6,** Rodkin et al. do not explicitly teach **determining a general topic of the text, wherein the character strings contained in the database are selected based upon the topic.** However, Rodkin et al. do teach that *the method may comprise the further steps of receiving designated character strings ... wherein the designated character strings are designated by an administrator input ... the method may comprise the further steps of communicating with a search engine for searching an information network using the designated character strings as search terms to obtain corresponding destination addresses; and updating the destination database with the corresponding destination addresses.* (Column 10, lines 25 – 38). It would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. to determine a general topic, by administrator input and search engine results, so that the users are only provided with further information about the major theme(s) or general topic of the text.

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14. **Regarding dependent claim 7**, Rodkin et al. do not explicitly teach that **only the first occurrence in the text of any character string is hyperlinked**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to use the invention of Rodkin et al. in that way because the skilled artisan would not want the user to believe that the other occurrences in the text of any character string are different links from each other and the first occurrence; thereby, allowing the user to checkout the other links and not have to constantly revisit links that the user has already seen.

15. **Regarding independent claim 8**, the claim incorporates substantially similar subject matter as claims 1 – 4, and is rejected along the same rationale.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER